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IN THE

# Supreme Court of the United States

OCTOBER TERM 1943

No. 392

UNIVERSAL OIL PRODUCTS COMPANY,
a corporation,

*Petitioner,*

v.

GLOBE OIL & REFINING COMPANY,
a corporation,

*Respondent.*

## PETITION OF UNIVERSAL OIL PRODUCTS COMPANY FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF

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## PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

*To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:*

Your petitioner, Universal Oil Products Company, prays that a writ of certiorari issue to review a final judgment of the United States Circuit Court of Appeals for the Seventh Circuit entered June 30, 1943, pursuant to its opinion finding not infringed, if valid, petitioner's patents 1,392,629, Carbon P. Dubbs, granted October 4, 1921, and 1,573,593, Gustav Egloff, granted May 12, 1925, and shows as follows:

A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

## JURISDICTIONAL STATEMENT

Jurisdiction is invoked under Section 240 (a) of the Judicial Code as amended by Act of February 13, 1925 (28 U. S. C. Sec. 347), and under Section 262 of the Judicial Code, Act of March 3, 1911 (28 U. S. C. Sec. 377). The case arises under the patent laws. The judgment, of which review is sought, is dated June 30, 1943 and is final in that it affirms the judgment of the District Court dismissing the complaint (v. VII, p. 3585).[1]

## SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED

Petitioner, a corporation of Delaware, employs a staff of chemists, physicists, engineers, and petroleum technologists, and maintains an extensive experimental laboratory and has for many years been actively engaged in research in connection with, and in the development of, processes and apparatus for producing gasoline by cracking, and in the commercial introduction thereof. Among such processes is that disclosed in and practiced under the Dubbs patent in suit.[2]

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[1]References are to the certified transcript; Roman numerals refer to volume and Arabic numerals to page.

[2]Petitioner demonstrated to the refining industry the revolutionary character of the Dubbs process and its accomplishments (p. 5-7, 10, *infra*), induced important refiners to adopt it under licenses, in many instances supervised for them the installations of apparatus for practicing the process, and in most instances guaranteed the successful performance thereof. From

Respondent, a corporation of Illinois, is one of the members of a confederacy, or group of refiners, formed for the purpose of defending any infringement suits brought against any of its members because of their use of the so-called "Winkler-Koch process". The Winkler-Koch process emanated from the Winkler-Koch Engineering Company, which was organized in the Summer of 1927, or its *alter ego*, the Winkler-Koch Patent Company.[1]

The decision and judgment of the Court of Appeals in the case at bar are in direct conflict with those of the Third Circuit in a suit (*Universal Oil Products Co.* v. *Winkler-Koch E. Co.*, 6 F. Supp. 763, aff'd 3 Cir., 78 F. [2d] 991, cert. den. 296 U. S. 626), hereinafter referred to as the "*Root* case", wherein both the aforesaid Dubbs and Egloff patents were found to be valid and to have been infringed by the practice of the "Winkler-Koch process."[2] In both suits the same claims were involved, namely, all of the claims of the Dubbs patent (except claim 6) and all of the claims of the Egloff patent.

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the outset petitioner adopted the policy of licensing its patented inventions to all comers—the small as well as the large refiner—for a low royalty per barrel of oil treated. It has never itself engaged in commercial refining.

[1]No patent or patent application of this company is identified in the proofs, nor did respondent attempt to establish the provenience of the Winkler-Koch process.

[2]Root Refining Company, like the respondent, was a member of the confederacy, formed in 1929, which defended both the *Root* case and the case at bar. Upon preliminary hearing, the District Court, finding in the instant case that respondent was in privity with the defendants in the *Root* case, initially held that the decree in the *Root* case was "conclusive" against respondent "on the issues of the validity and infringement of the Dubbs and Egloff patents" (27 F. Supp. 161, 167). Subsequently, upon motion for rehearing on this issue and upon a showing that the defendant in the *Root* case, acting independently of the other

There is no difference between the infringing Winkler-Koch process as practiced by the defendant in the *Root* case and the Winkler-Koch process as practiced by respondent in the instant case, although there are some slight differences in operating conditions, as indicated on Pl. Ex. 598 (v. IV, p. 1863); where there are differences, the notations in red refer to Root Refining Company's operations (v. II, p. 695-7). The differences, however, are of no consequence (v. II, p. 697) and were not urged by respondent in the courts below as distinguishing the two cases; they are not so much as mentioned by either of the lower courts in the instant case.

Although both patents have expired, there are a number of other suits pending against different defendants in the Third and Tenth Circuits[1]; all of these suits involve the validity of one or both of the patents here in suit and like infringement questions; none of them has been tried. All of them would be disposed of by a decision of this Court.

*The Dubbs Patent.* The state of the art being commercially practiced when Dubbs appeared on the scene was the Burton process and its successor, the Burton-Clark

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members of the confederacy, had settled petitioner's claim for damages and profits and accepted one of its standard licenses, the District Court reversed its holding that respondent was bound by the *res judicata*. It held that the settlement deprived respondent and the remainder of the group of the "opportunity" to proceed further in the *Root* litigation, and concluded that "the issues of the validity of the patents and their infringement by defendant herein are open for litigation in this case" (31 F. Supp. 665, 667).

[1]The affidavit of Hiram J. Halle filed in support of this petition (p. 25-6, *infra*) enumerates some of the pending cases.

process.[1] The latter first appeared about 1915. Neither Burton nor Burton-Clark was capable of cracking other than selected light oils produced by distillation of petroleum. These processes were non-continuous or "batch" processes. The formation and accumulation of carbon inside the still created a constant fire and explosion hazard to life and property. The gasoline yields were between 28% and 33% by volume of the oil charged. The productive periods were limited to 24 and 36 hours, respectively, and were separated by unproductive periods of equal lengths caused by the necessity of shutting down to remove the accumulation of carbon (v. I, p. 486-90).

In contradistinction, the Dubbs process was not limited to the cracking of selected distillate stocks but could also crack crude and other heavy oils; similarly it so greatly mitigated the carbon evil as to permit substantially continuous cracking operation. For example, in a demonstration run in 1919, the process ran uninterruptedly for nine days and was then shut down, not because of carbon or other troubles, but solely because the representatives of the National Petroleum Association and Western Refining Association in attendance stated they were satisfied (v. I, p 377).

As the District Judge, Honorable William H. Holly, found in the instant case (40 F. Supp. 575, 577-8):

> "The Dubbs process was recognized immediately by the larger oil companies as a great improvement in the art and the older processes of producing gasoline were practically abandoned."

[1]The unit used in practicing the Burton process is shown by Pl. Ex. 504 (v. IV, p. 1697); that used in the Burton-Clark process by Pl. Ex. 515 (v. IV, p. 1699).

One of the large oil companies utilizing the Dubbs process installed four 500 barrel units and kept them in operation from 1923 to 1936, treating during the thirteen year period more than 4,000,000 barrels of oil; each unit remained in continuous operation for runs averaging approximately 22½ days before being required to be shut down for cleaning, and the gasoline yield was 40.57% by volume of the oil charged, a large increase over the gasoline yield achieved in prior practices (v. II, p. 615).

Up to December 31, 1929, 256 Dubbs units had been constructed at a cost of almost $46,000,000 for practicing the process (v. II, p. 615-6), and 190,000,000 barrels of oil had been treated therein (Pl. Ex. 586, v. IV, p. 1818).

After a thorough analysis of the prior art and the accomplishments of the Dubbs process, Judge Holly, in the instant case, concluded *inter alia* (40 F. Supp. 575, 578, 579):

> "With great skill and ingenuity counsel for the defendant have argued that these patents [the art prior to Dubbs] clearly teach all that is contained in the Dubbs process. But the stubborn fact remains that the great oil companies with their staffs of highly trained technical experts never found it out * * *. If the prior art taught clean circulation so clearly, how did it happen that nothing better than the Burton and Burton-Clark systems was developed?"
>
> * * * * * * * *
>
> *"This is more than mere commercial success. Here the recognized experts in the art saw the Dubbs*

[1]The Dubbs process is generally known in the refining art as the "clean circulation process" for the reasons hereinafter discussed (p. 8-9, *infra*).

*process as new and revolutionary. And who was better qualified to judge?"*[1]

The Dubbs process,[2] as exemplified in the patent, involves forcing the oil to be cracked, in a stream under high pressure, through an externally fired pipe-coil consisting of four-inch-diameter tubes, identified in the patent as "cracking tubes B". From these "cracking tubes B", the oil passes into ten-inch-diameter tubes, identified in the patent as "vaporizing tubes C". The cross-sectional area of the C tubes is 625 per cent. of that of the B tubes. In the "cracking tubes B" the oil travels at high velocity, while in the "vaporizing tubes C" it travels at a relatively low velocity.

At the temperature-pressure range given in the "illustrative run" in the patent specification, from 20 per cent. to 90 per cent. of the oil stream, while travelling through the "cracking tubes B", is converted to vapor, *i.e.*, vapor is *generated* to that extent (v. II, p. 656). Due to the stream velocity and resulting turbulence in the "cracking tubes B", however, the vapors, so generated, are homogeneously distributed in the non-volatilized oil with the latter in a continuous external phase, the two forming a foamy mass prior to the discharge of the stream into the "vaporizing tubes C". In other words, there is no separation, segregation or *liberation* of the vapor from the liquid while in the "cracking tubes B" (v. II, p. 655-6). A velocity through the "cracking tubes B" sufficient for effecting efficient heat transfer to the oil is adequate for obtaining the turbulence aforesaid. Conversely, as the result of the larger cross-sectional area of the "vaporizing tubes C", the stream,

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[1]All italics are supplied unless otherwise noted.

[2]See Pl. Ex. 509, v. IV, p. 1707; Dubbs patent, v. VII, p. 3089.

travelling through them relatively slowly and tranquilly, presents a large vapor *liberating* surface with an unobstructed super-adjacent vapor separating space, thereby permitting the generated vapors continuously to separate or *liberate* themselves from the non-volatilized oil. In other words, the "vaporizing tubes C", which have a much greater diameter than the "cracking tubes B", are only partially filled with liquid and, since the mixed oil and vapor pass through them relatively slowly, the *liberation* of the vapor takes place therein (v. II, p. 655).

The residue from this vapor liberating step is constantly withdrawn from the "vaporizing tubes C" and sent to storage in the particular apparatus shown (v. II, p. 654).

The separated or liberated vapors pass from the "vaporizing tubes C" to an initial condenser $G^1$, in which part of the vapors is condensed; from this initial condenser $G^1$ the uncondensed vapors pass by a vapor line $G^2$ to a final condenser $G^3$ which, in turn, discharges into a receiver having valve-controlled incondensible gas and liquid draw-off lines (v. II, p. 653-4).

The condensate from the initial condenser, called "reflux condensate", is cycled through the "cracking tubes B", uncontaminated by the residue left behind in the "vaporizing tubes C". This residue is not cycled. At the entrance to the "cracking tubes B", the reflux condensate meets and is mixed with the fresh charge and the mixture travels through these tubes (v. II, p. 654). The resulting cracking of the reflux adds greatly to the gasoline yield; the reflux in the fresh feed is of material importance in retarding the formation of carbon in the cracking tubes (v. II, p. 657-8).

The crux of the Dubbs invention lies in the cycling of the uncontaminated reflux condensate through the "crack-

ing tubes B", mixed with the fresh feed, and the non-cycling of the residue. This is called "clean circulation"[1] (v. II, p. 663).

Were the residue, or any substantial part thereof, cycled during an operation, the unit would have to be closed down much sooner due to the formation and accumulation of carbonaceous material in the "cracking tubes B".

What we have called the crux of the Dubbs process is recited in claim 7 of the Dubbs patent as follows (v. VII, p. 3091):

> "* * * returning the condensate from said initial condensation to the inlet side of the cracking tubes and continuously drawing off the residue from the vapor chamber and preventing it from returning to the cracking zone * * *."

(a)

In addition to the foregoing recital of the vitalizing feature of the Dubbs invention, that claim recites that the oil in passing through a series of tubes ("cracking tubes B") seated in a cracking zone, "is heated to the cracking temperature but substantial *vaporization* prevented."

The conflict between the *Root* case and the case at bar revolves around the meaning given to the word "vaporization" in the patent claims. The District Court in the instant case succinctly framed the contentions of the respective parties as follows (40 F. Supp. 581):

> "Defendant says that the word *vaporization* means *generation* of vapors and that plaintiff's patent limits his process to one in which no vapor is generated in the initial tube or chamber where the heat

[1]No court has asserted that what we have defined as the crux of the Dubbs invention is not exhibited in (a) the practice of respondent's process, (b) the process disclosed in the Dubbs patent, (c) the demonstration runs, and (d) the process practiced by petitioner's licensees.

is applied. Plaintiff says vaporization means *liberation* of vapors and that his patent provides for generation of vapor in the heating chamber and liberation in the second chamber. If plaintiff's interpretation is correct, defendant infringes."

Respondent conceded that in the operation of the accused process there is substantial *generation* of vapor in the cracking coil and that there is no *liberation* of vapor until the oil has passed into the large unheated "separator" (v. IV, p. 1863), corresponding to the "vaporizing tubes" in the Dubbs patent.

In the petitioner's process a similar phenomenon prevails. This was shown, for example, in the demonstration runs of the Dubbs process.

These runs were made by petitioner and Dubbs in 1919 in a unit closely resembling the apparatus of the Dubbs patent (Pl. Ex. 519, v. IV, p. 1727). The first was made, prior to the filing of the application for the Dubbs patent (v. I, p. 522), for Daniel Pyzel, a petroleum technologist, in charge of the technical development and supervision of refining for Royal Dutch Shell (v. I, p. 505), which subsequently made installations of the process under licenses from petitioner (v. I, p. 514). The other demonstration, contemporaneous with the filing of the application for the Dubbs patent, was made for a group of oil technologists and refiners, and has been previously referred to herein (footnote p. 2, *supra*). During these runs substantial vapor *generation* occurred in the stream of oil passing through the "cracking tubes B," but the vapors were *not separated* from the liquid therein. This separation or liberation of the vapors occurred only in the "vaporizing tubes C"[1] (v. II, p. 687-8).

[1]The same phenomenon was exhibited in the practice of the Dubbs process by petitioner's licensees prior to respondent's advent (v. I, p. 514-5; v. II, p. 551-2, 688-94). Respondent has never denied this.

The decisive issue in both the *Root* case and the instant case was whether the limitation in the claims of the Dubbs patent, that the process was one in which "substantial vaporization [is] prevented" in the "cracking tubes B," when properly construed, excluded from the patent Dubbs' "revolutionary" process, and, by the same token, respondent's process.

In construing the word, "vaporization", the District Court in the instant case accepted respondent's contention and rejected that of the petitioner, saying (40 F. Supp. 575, 581, 584):

> "The generally accepted meaning of the word [vaporization] among scientists and the laity as well seems to be *generation* of vapor."
>
> * * * * * * * *
>
> "I am forced to the conclusion that the patent does not show that Dubbs used the term vaporization in any other than the commonly accepted meaning of *generation* of vapor."

The court made no attempt to reconcile this conclusion with the "illustrative run" of the patent specification.

The majority opinion of the Court of Appeals in the instant case states that "we are satisfied to adopt that part of Judge Holly's opinion (40 F. Supp. 581) which deals with infringement of the Dubbs patent."[1]

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[1]Antithetically, the opinion also says (v. VII, p. 3583):

> "In defendant's apparatus the oil is cracked and vaporized in what might be called its B tubes and this is so whether we accept plaintiff's or defendant's definition of vaporization."

This can only mean that in the court's view the *generated* vapors are *liberated* in the respondent's B tubes from the non-volatilized oil.

In the *Root* case,[1] the Circuit Court of Appeals for the Third Circuit, after analyzing the same patent, rejected

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It is manifest, in spite of the foregoing, that in the practice of respondent's process, vapor *generation* occurs in the cracking tubes, but vapor liberation does not there occur.

Respondent's expert Smith said (v. III, p. 1125):

> "As vaporization [the term religiously used by this expert as the symbol for vapor *generation*] proceeds in defendant's coil the vapors thus formed remain mixed up with the stream of oil due to the agitation which is imparted by the velocity of the flow in there so that the vapors and liquid move along together * * *. The vapors have to travel along the entire length of the coil. * * * It is a mixed phase cracking operation."

This is precisely what occurs in the Dubbs process. As respondent's counsel, when acting for the defendant and the Winkler-Koch confederacy in the *Root* case, said of the operation of the Dubbs process (78 F. [2d] 991, 998):

> " 'The physical condition of the on-rushing stream of oil in these tubes [cracking tubes B] would be such as to *preclude the possibility of a condition where a tranquil liquid level could exist from which vapors might be separated and liberated from the liquid.* * * * On the other hand, in the ten-inch C tubes of the patent, the velocity of the stream is greatly decreased. These C tubes are only partially filled thereby providing a liquid level from which *vapors generated* in the *cracking operation are released* and escape through the vapor lines D of the patent * * *' "

In the *Root* case it was held that the expression "cracking tubes B" in the Dubbs process was not a misnomer, that cracking did occur in these tubes, and therefore that vapor *generation* occurred therein, but that "vaporization," *i.e.*, *separation* of the generated vapors from the non-volatilized oil, did not occur there.

In accord with this interpretation, see observations of District Judge in the instant case (footnote p. 33, *infra*).

The Court of Appeals in the instant case is the first even to infer that "vaporization" (giving the word petitioner's definition) occurs in respondent's cracking coil, corresponding to petitioner's "cracking tubes B".

[1]The District Court in the *Root* case said (6 F. Supp. 763, 767-70):

> " 'Vaporization,' in the phrase 'without substantial vaporization' in claim 1 of the Dubbs patent and in the

the contention that, as used in the claims of the Dubbs patent, "vaporization" is the symbol for vapor generation, and concluded (78 F. [2d] 991, 998):

> "He [Dubbs] thus defines 'vaporization' by the words, *'liberation* of vapors'. It is in this sense that 'vaporization' is used in these claims."

Thus it appears that the two Circuit Courts of Appeal in construing the same patent have reached diametrically opposed results on the meaning of the claim.

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> equivalent phrases of the other claims, *does not mean cracking*" (*id.*, 767).
>
> * * * * * * * *
>
> "The phrase 'without substantial vaporization' was manifestly intended to exclude the familiar vapor phase cracking (*id.*, 768)
>
> * * * * * * * *
>
> "Vaporization can connote the mere generation of vapors in a body of liquid. *The adoption of this construction would result in a finding that the claims in suit are invalid because they involve a departure from the specification of the patent.* On the other hand, vaporization may connote the generation of vapors in a body of liquid accompanied by the liberation or separation of the vapors from the liquid or may connote the mere liberation or separation of the vapors from the body of the liquid. *The adoption of either of the latter constructions will not result in destruction of the claims*" (*id.*, 770).

Describing the operation of the Root process the court said (*id.*, 769):

> "In the travelling of the oil through the soaking section considerable generation of vapor occurs but *there is no liberation of the vapor from the oil until it reaches the vaporizing chamber*."

To hold that the phrase of the claim ("substantial vaporization prevented") means that vapor *generation* is prevented in the "cracking tubes B" is to hold that the claim is at variance with the phenomenon which would inevitably be exhibited in practicing the Dubbs process according to the operating conditions of the "illustrative run" of the patent specification (v. II, p. 687). It is submitted that any petroleum technologist, including the learned Patent Office Examiner, would have known that, under said conditions, the creation or *generation* of vapors would necessarily occur in the "cracking tubes B". Hence, it is unreasonable to assume that Dubbs, educated as a chemist and an experienced petroleum technologist (to whom the boiling points of the various fractions of petroleum must have been as familiar as the boiling point of water), would have deliberately introduced into his application a phrase ("substantial vaporization prevented") which would have been a misdescription of the phenomenon which inevitably occurred in the practice of his process. Fame and fortune awaited the issuance to him of a patent adequately covering his process. Can it be assumed, therefore, that Dubbs would have *intended* a meaning to be given to the word "vaporization", as used in his patent claims, which would defeat his purpose?

Nevertheless, the majority of the court below, disregarding the definition of the word "vaporization" manifestly intended by Dubbs, concluded on the basis of their own knowledge, and with the aid of some dictionaries,[1] that

[1]In any event other dictionaries and textbooks support the meaning advanced by petitioner. For example, "Elements of Physics," by Prof. Hoadley of Swarthmore College, under "Vaporization" gives its mechanics as follows: "As the molecules of water in their vibration strike against the surface many of them

the meaning to be given to "vaporization" in the patent was *generation* of vapor, a conclusion which, as this Court will observe, is wholly at variance with the inevitable phenomenon occurring when oil is subjected to the conditions prescribed in the patent specification. In adopting this construction, the court below wholly disregarded the context and determined the question *in vacuo*.

Judge Lindley disagreed with the reasoning of the majority because he believed the patent was invalid *but observed that, if valid, it was infringed.* Since there is no dispute as to the facts, it would appear that he necessarily adopted petitioner's contention as to the meaning of the word "vaporization" as used in the claims of the patent.

(b)

The Court of Appeals in the instant case also held that an applicant, who uses words of common meaning in his patent claim and finds that they do not cover *a subsequently created structure,* will not be permitted to give a new or different meaning thereto to make it cover such structure. The court must have believed that such a doctrine was applicable to the facts in the present case (v. VII, p. 3580).

Such doctrine has no application. To the contrary, the claim, as construed by petitioner, perfectly fits the process as practiced in the 1919 *demonstration runs* (p. 10, *supra*). The proofs indubitably show that the process had been publicly practiced *prior to and was being practiced substantially contemporaneously with the presentation of*

force their way through it *and pass into the air* where they exist as molecules of water vapor. When heat is applied, the temperature is raised, which means that the velocity of the molecules is increased; and the number of molecules that *pass into the air* increases with their velocity" (v. II, p. 780).

*the claims as ultimately granted* (v. II, p. 687-8). Thus, instead of placing a *new or different* meaning on the claim in order to make it cover after-appearing processes, petitioner has always insisted upon a meaning for the claim which corresponds to the very process thus publicly demonstated and upon which Dubbs' application was based.

(c)

The Court of Appeals, observing that the claim as originally presented was rejected and was re-submitted after the addition thereto of the phrase, "where the oil is heated to the cracking temperature but substantial vaporization prevented," said that without this addition "the rejection would have stood."

Such assumption is unjustified. The quoted phrase was not relied upon at all for distinguishing the claim from the Patent Office citations (v. IV, p. 1509-48). The step stated in the quoted phrase was not novel with Dubbs; it is not asserted to be novel in the patent or in any argument filed in the proceedings leading to the patent grant. The phrase was probably inserted, as stated by Judge Nields (6 F. Supp. 763, 768), out of an abundance of caution to exclude the old, unsuccessful, vapor-phase processes.[1]

In any event, since the claim, as granted, accurately defines respondent's process, the fact that the criticized words were added by amendment, while possibly relevant to the question of the *validity* of the patent, has no relevancy to the question of its infringement.[2]

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[1]The Texas Company found that gasoline produced by the Hall vapor-phase process cost about 68 cents per gallon (v. II, p. 976).

[2]The Court of Appeals, however, decided the case on the issue of infringement; it *assumed* validity.

*The Egloff Patent.* When Egloff entered the field, the Dubbs process was in extensive use, but Egloff realized that some oils were particularly rich in potential carbon forming materials and were, therefore, not as favorable for treatment by the Dubbs process as other oils. Egloff's invention is a process which involves combining with the Dubbs process a preliminary step constituting what might be called a "once through" procedure, whereby, at a minimum installation and operating cost, these less desirable oils are treated for transforming them in considerable part into cracking stock or "fresh feed", much more suitable for treatment by the Dubbs process. To this end Egloff provided a low temperature coil (7),[1] through which this less desirable oil is passed, for effecting a mild cracking. The oil thus treated then joins the stream from the high temperature coil (6) ["cracking tubes B" of the Dubbs unit], and the two, intermixed, are discharged into a single vaporizing chamber (12) ["vaporizing tubes C"]. The common residue is drawn off and not cycled. The vapors liberated from the mixed stream in the vaporizing chamber pass off into an initial condenser (21). The condensate formed in the initial condenser (21) from the vapors emanating from the oil charged to the low temperature coil (7) constitutes the fresh feed for the coil (6), and the condensate formed in the initial condenser from the vapors of the oil that has passed through the high temperature coil (6) corresponds to the "reflux condensate" of the Dubbs process. The vapors passing from the initial condenser follow the course hereinabove stated in describing the Dubbs process.

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[1]See Pl. Ex. 510, v. IV, p. 1709; Egloff patent, v. VII, p. 3095; the numbers in the above paragraph correspond with those used in the patent.

In the instant case the District Judge found the Egloff patent invalid. The Circuit Court of Appeals, without adopting or disapproving the District Court's opinion as to validity and without discussing the claims of the patent, found it not infringed by the Winkler-Koch process.[1] On the contrary, the Circuit Court of Appeals for the Third Circuit, as well as the District Court, in the *Root* case found the Egloff patent valid and infringed by the Winkler-Koch process (78 F. [2d] 991, 999).

Although the Egloff patent is entitled "process of treating oil" and contains only process claims, the majority opinion of the Court of Appeals in the case at bar remarked that Egloff's drawings and specifications "suggest a product patent." Although fully half the specification is addressed to a description of the apparatus employed, the opinion says that "no apparatus is described".[2] The Court further said that respondent "not only proceeds differently by its process but the differences are both additions and elimination of steps." The Court did not point out a single difference, or indicate what additions or eliminations were made by respondent as compared with the process defined by the Egloff claims. It merely observed that the respondent's brief pointed out the distinction between its process and the "*claims* of the patent." In fact, that brief did not point out any claim step allegedly lacking in the accused process.

Finally, the opinion below stated that "defendant's *structure* is far out of the reach of Egloff's disclosure".

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[1]Judge Lindley, on the other hand, was of the opinion that the patent is invalid, but expressed no opinion on the infringement question.

[2]See description of apparatus in Egloff patent (v. VII, p. 3095, lines 22-84) which the Court of Appeals evidently overlooked.

This is of no legal significance. The Circuit Court of Appeals for the Third Circuit is wholly in conflict on the controlling question of infringement, for it held (78 F. [2d] 991, 999) that Root "infringed the Egloff patent whose *process* the appellant has *substantially followed.*"

## QUESTIONS PRESENTED

1. Are the Dubbs and Egloff patents, or either of them, infringed by the Winkler-Koch cracking process, as was held in the *Root* case, or are they not infringed thereby, as was held in the case at bar?

2. Is the rule—that if a claim is fairly susceptible of two constructions, that construction should be adopted which will secure to the patentee "the fruits of his invention", rather than a construction fatal to the grant—to be applied only to pioneer patents, or is it to be applied as well to improvement patents for meritorious inventions?

3. If the Dubbs claims in suit are susceptible of two interpretations, one of which sustains and vitalizes the patent and the other of which emasculates it, then, since the invention was "revolutionary" and a material aid in the conservation of one of the nation's most valued resources, did the courts in the instant case err in adopting the latter rather than the former interpretation?

4. In determining the meaning of a word as used in a claim of a process patent, may a court adopt its own idea of the general and usual meaning of the word, or the definition found in some dictionaries and textbooks, and disregard the patent specification, and particularly a typical operation given therein for illustrating the process intended to be patented?

5. In determining the meaning of a word as used in the claim of a process patent, and the consequent scope of the claim, may a court adopt as correct its own idea of such meaning, or the definition found in some dictionaries and textbooks, and by reason thereof place a construction on the claim at variance with (a) the disclosure in the patent taken as a whole, (b) actual public operations by the patentee for demonstrating his process, made immediately preceding and contemporaneously with the filing of the patent application, and (c) the process as practiced by leading refiners under royalty licenses?

6. Does the rule, that the language in a patent claim will not be given a new or different meaning from that intended when first used in order to bring a subsequently created structure within the purview of the claim, have any application where, as in the instant case, the claim reads on the accused process in the same way that it reads upon the process which the patentee had publicly demonstrated immediately prior to the filing of his patent application and contemporaneously with the insertion of said claim language in his claim?

7. Does the re-submission of a rejected claim, pursuant to R. S. 4903, U. S. C. Title 35, Sec. 51, with a non-novel step added and accompanied by an argument making manifest that features appearing both in the original and re-submitted claim were those (a) relied upon for distinguishing the claim from the Patent Office citations, and (b) which in fact gave the claimed invention its magic, warrant the assumption that, without the addition, the Patent Office rejection would have stood and that therefore the claim as granted excludes an accused process which exhibits both the novel features and the added features?

8. Are the Dubbs patent and the Egloff patent, or either of them, valid and infringed by the practice of respondent's process?

## REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT

Exercise of the discretionary power of this Court to grant the writ of certiorari herein prayed is asked upon the following grounds:

(1) The Court of Appeals in the instant case on the same matter rendered a decision in conflict with that of the Court of Appeals for the Third Circuit as to both the Dubbs patent and the Egloff patent.

(2) It would be in the public interest and result in the conservation of the time and labor of the courts in the Third and Tenth Circuits, where suits against other parties on the same patents are now pending untried, for this Court to resolve the conflict.

(3) The Court of Appeals, in determining the meaning, as used in the claims of the Dubbs patent, of the word "vaporization", which meaning is controlling upon the construction of said claims and the infringement question, used a method which is untenable, is in conflict with the decisions of other Circuit Courts of Appeal, and is probably in conflict with the applicable decisions of this Court.

(4) The Court of Appeals misapplied to this case the rule, that the language of a patent claim cannot be given a meaning new or different from that intended when the

claim was allowed in order to cover a subsequently appearing structure, resulting in a decision on the infringement question probably in conflict with the applicable decisions of this Court.

(5) The Court of Appeals, in finding non-infringement of the Dubbs patent, which indubitably is for a valuable invention, disregarded the rule, laid down by applicable decisions of this Court, that in such case if the patent claim is susceptible of two interpretations, one of which will sustain and vitalize the patent and the other emasculate it, the former will be adopted.

(6) The Court of Appeals, in basing its finding of non-infringement of the Dubbs patent in whole or in part upon its determination that, following a Patent Office rejection, the claim was granted after it had been re-submitted with a feature added, in the absence of which the rejection would have stood, and that such factors are relevant on the infringement issue, notwithstanding the fact that the putative infringing process exhibits the whole of the re-submitted claim, has decided an important question of patent law in a way probably in conflict with the applicable decisions of this Court.

(7) In determining the meaning of the claim-word, "vaporization", the Court of Appeals erroneously conditioned the meaning of the said claim-word by the asserted circumstance that the patent is for an improvement invention, and thereby decided an important question of patent law in a way probably in conflict with the applicable decisions of this Court.

(8) The holding of non-infringement of the Egloff process patent by the Court of Appeals, being based in part at least on its finding that respondent's structure is far out of reach of Egloff's disclosure and in part on the finding that respondent's process had added and eliminated steps as compared with that of the patent, is probably in conflict with the applicable decisions of this Court.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Court directed to the Circuit Court of Appeals for the Seventh Circuit, commanding that court to certify and to send to this Court for its review and determination, on a day certain to be named therein, a full and complete transcript of the record and all proceedings in the case numbered and entitled in its Docket No. 7912, Universal Oil Products Company, Plaintiff-Appellant v. Globe Oil & Refining Company, Defendant-Appellee, and that said judgment of the Circuit Court for the Seventh Circuit may be reversed by this Court and that your petitioner may have such other and further relief in the premises as to this Court may seem just; and your petitioner will ever pray.

UNIVERSAL OIL PRODUCTS COMPANY,
*Petitioner.*

By ALEXANDER F. REICHMANN,
WILLIAM F. HALL,
CHARLES M. THOMAS,
RALPH S. HARRIS,
WALTER J. BLENKO,
*Attorneys for Petitioner.*

IN THE

# Supreme Court of the United States

OCTOBER TERM 1943

No.

UNIVERSAL OIL PRODUCTS COMPANY, a corporation,
*Petitioner,*

v.

GLOBE OIL & REFINING COMPANY, a corporation,
*Respondent.*

## AFFIDAVIT OF HIRAM J. HALLE SUBMITTED IN SUPPORT OF A PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

STATE OF NEW YORK
COUNTY OF WESTCHESTER } ss.:

HIRAM J. HALLE, being duly sworn, deposes and says:

That he is a citizen of the United States and a resident of the State of New York and is the President of the petitioner;

That he knows that there are now pending, untried, in the United States District Courts within the Third Judicial Circuit the following cases, all of which are based

upon the Dubbs patent No. 1,392,629, granted October 4, 1921, and one of which is also based upon the Egloff patent No. 1,573,593, granted May 12, 1925:

Universal Oil Products Company vs. Octane Oil Refining Company (both patents);

Universal Oil Products Company vs. Crew Levick Company (Dubbs patent); and

Universal Oil Products Company vs. Empire Oil and Refining Company (Dubbs patent).

That he knows that there are now pending, untried, in United States District Courts within the Tenth Judicial Circuit the following infringement suits based upon one or both of the same patents:

Universal Oil Products Company vs. Anderson-Prichard Oil Company (both patents);

Universal Oil Products Company vs. Eldorado Refining Company (both patents);

Universal Oil Products Company vs. Globe Oil and Refining Company (both patents);

Universal Oil Products Company vs. Rock Island Refining Company (both patents); and

Universal Oil Products Company vs. Omar Refining Company (Dubbs patent).

HIRAM J. HALLE

Sworn to before me this
25th day of September,
1943.

LEO MORGAN HEALY
Notary Public, Westchester County
Certificate filed in N. Y. Co. No. 850
Commission expires March 30th, 1944

IN THE

# Supreme Court of the United States

OCTOBER TERM 1943

No.

UNIVERSAL OIL PRODUCTS COMPANY, a corporation,
*Petitioner,*

v.

GLOBE OIL & REFINING COMPANY, a corporation,
*Respondent.*

## BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

### OPINIONS OF THE COURTS BELOW

The opinion of the Circuit Court of Appeals in the instant case is reported at 137 F. (2d) 3 (v. VII, p. 3575). The opinion of the District Court is reported at 40 F. Supp. 575 (v. VI, p. 3035).

The opinion of the Circuit Court of Appeals for the Third Circuit in the *Root* case is reported at 78 F. (2d) 991. The opinion of the District Court in the *Root* case is reported at 6 F. Supp. 763.

## JURISDICTION

The facts supporting the jurisdiction of this Court are set forth in the petition.

Cases believed to sustain the jurisdiction are as follows:

*Layne & Co.* v. *Western Well Works*, 261 U. S. 387, 392;

*Magnum Co.* v. *Coty*, 262 U. S. 159, 163;

*Sanitary Refrig'r Co.* v. *Winters*, 280 U. S. 30;

*Smith* v. *Snow*, 294 U. S. 1.

## STATEMENT OF THE CASE

The facts are sufficiently set forth in the petition.

## SPECIFICATION OF ERRORS

If the writ is granted, petitioner will urge that the Court of Appeals in the instant case erred in the following respects:

(1) In not holding that the Dubbs and Egloff patents are valid and infringed by the practice of respondent's process as charged in the bill.

(2) In finding non-infringement of the Dubbs patent and the Egloff patent by respondent's process.

(3) In giving an incorrect meaning to the word "vaporization" as used in the Dubbs patent, resulting in

an erroneous construction of its claims and a finding of non-infringement rather than a finding of infringement.

(4) In finding that the words "substantial vaporization prevented" state an action which "points to the heart of a vital step in the Dubbs process," and ignoring the features (a) which vitalize the process as actually practiced immediately prior to, contemporaneously with, and subsequent to the filing of the patent application, (b) which are necessarily exhibited in the practice of the process under the operating conditions of the "illustrative run" of the patent specification, and (c) which were stressed in the prosecution of the application; these features being the cycling of the uncontaminated reflux-condensate through the cracking tubes admixed with the fresh feed, and the non-cycling of the residue.

(5) In not finding that the feature of preventing "vaporization" in the "cracking tubes B" was never stated by Dubbs to be novel, or stressed in the prosecution of his application.

(6) In finding that Dubbs obtained the phenomenon defined by the phrase "but substantial vaporization prevented" by the use of different size tubes and the application of heat and its withdrawal when the cracking point was reached.

(7) In finding that in respondent's apparatus the oil is "vaporized" in what are described as the "cracking tubes B", even though petitioner's meaning is given to the word "vaporization."

(8) In finding that respondent did not provide an apparatus for preventing substantial "vaporization", even if petitioner's meaning of "vaporization" is accepted.

(9) In finding that, no matter what meaning is given the word "vaporization", there was no prevention but an encouragement of that phenomenon in the practice of respondent's process.

(10) In finding that the oil cannot be heated to the cracking point without "vaporization", according to petitioner's meaning of "vaporization."

(11) In arriving at the meaning of the word "vaporization" as used in the patent claim without reference to (a) the whole patent, and particularly the "illustrative run" of the patent specification; (b) the phenomenon exhibited in the Dubbs process as publicly demonstrated by petitioner and the patentee immediately prior to and contemporaneously with the filing of the patent application, and prior to and contemporaneously with the first use of the questioned word in the patent claim; and (c) the phenomenon exhibited in the process as practiced by many refiners under royalty licenses from petitioner prior to respondent's advent.

(12) In narrowly construing the claims of the Dubbs patent on the asserted circumstance that, at best, the invention was in the nature of an improvement and the language of the claims should be construed accordingly.

(13) In not applying the rule that, if the matter were doubtful, the character of the Dubbs patent and its commercial and practical success are such as to entitle the inventor to broad claims and to a liberal construction of those which he has made.

(14) In not giving the claim of the Dubbs patent a construction commensurate with the demonstrated worth of

the patentee's invention but rather a construction which emasculates the patent.

(15) In finding applicable to the facts of the instant case the rule that the meaning which the inventor gives to his words cannot be made to depend upon subsequent events, and that he will not be permitted to place on his claim language a new, or different, meaning from that intended when the claim was allowed, in order to cover a subsequently created structure.

(16) In finding that petitioner tried to give a new meaning to the word "vaporization", in order "to cover respondent's structure."

(17) In finding that the phrase, "but substantial vaporization prevented", which was added to the claims before their re-submission to the Patent Office after their rejection, (a) was "all important", (b) if absent would have caused the rejection to stand, and (c) requires such a restriction being placed on the claims as to exclude from their purview respondent's process.

(18) In finding that no apparatus is described in the Egloff patent.

(19) In basing the finding of non-infringement of the Egloff patent in whole or in part on the ground that "defendant's structure is far out of the reach of Egloff's disclosure," and on the ground that respondent's process, by both the addition and the elimination of steps, differs from Egloff's.

## ARGUMENT

### POINT 1

### THERE IS A CONFLICT BETWEEN DIFFERENT CIRCUITS ON THE SAME MATTER.

As the petition shows, there is a direct conflict between the judgment of the Circuit Court of Appeals in the instant case and the judgment of the Circuit Court of Appeals for the Third Circuit, on the issues of the interpretation of the claims of the Dubbs and Egloff patents, and the infringement of these claims by identical processes.

It is respectfully submitted that the conflict aforesaid should be resolved by this Court for the reason given by this Court in its opinions in the cases cited (p. 28, *supra*), and because of the present pendency of other suits (p. 4, 25-6, *supra*).

### POINT 2

### THE DECISION OF THE COURT OF APPEALS HEREIN IS IN CONFLICT WITH THE DECISONS OF THIS COURT AND OTHER CIRCUIT COURTS OF APPEAL.

(a)

In *Smith* v. *Snow*, 294 U. S. 1, 7, this Court said:

> "The question presented here is what scope may rightly be given to Claim 1 of the patent; whether the petitioner has drafted it in such form as to secure the fruits of his invention."

That is the precise question regarding typical claim 7 of the Dubbs patent in the instant case.

In the District Court the disposition of the Dubbs patent turned on the meaning ascribed by the court to the word "vaporization" as used in typical claim 7. That court concluded (a) that the word is used synonymously with vapor *generation*, (b) that vapor generation admittedly occurs in the cracking tubes in the practice of respondent's process, and (c) that in consequence the latter was non-infringing, since claim 7 recites that "vaporization" is prevented.[1] The Court of Appeals said it was "satisfied to adopt" the District Court's opinion on the infringement issue.

In reaching its conclusion the Court of Appeals ignored the following:

(1) The whole patent, and particularly the phenomena which would inevitably be exhibited, following the operating conditions of the illustrative run of the patent specification, in the practice of the process.

In so doing, the court below violated the rule laid down by this Court that the claims of a patent are always to be read or interpreted in the light of its specifications. *Hogg* v. *Emerson*, 11 How. 587; *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403; *Smith* v. *Snow*, 294 U. S. 1.

It also proceeded contrary to the *rationale* of the decisions of the Court of Appeals for the Third Circuit in the *Root* case (see p. 3, *supra*) and of the Circuit Court of Appeals for the First Circuit in *Doble Engineering Co.* v. *Leeds & Northrup Co.*, 1 Cir., 134 F. (2d) 78, 84.

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[1]On the other hand the District Judge held that if petitioner's interpretation were correct (*i.e.*, that "vaporization" as used in the claim is a symbol for the phenomenon of which liberation or separation of the generated vapors from the non-volatilized oil is a *sine qua non*), respondent infringed.

In the latter case the court said that, in ascertaining the meaning of a patent claim, "the whole instrument is to be interpreted with reference to the circumstances surrounding its inception" and the endeavor should be made to ascertain, "first what a patentee intended to claim as his invention or discovery and second upon what invention or discovery the patent office intended to grant a temporary monopoly."

The Circuit Court of Appeals for the Eighth Circuit made a like statement in *National Hollow B. B. Co.* v. *Interchangeable B. B. Co.*, 106 Fed. 693, cited by this Court in *Smith* v. *Snow, supra*. In that case, the Court of Appeals said the terms of the instrument should be read in the light of the facts and circumstances which surrounded the parties—inventor and Patent Office Examiner—when the instrument was drawn.

(2) The operations practiced by petitioner and Dubbs immediately prior to and contemporaneously with the filing of the Dubbs application, and contemporaneously with the introduction of the disputed phrase in the patent claim.

These demonstrations were for acquainting the refining industry with the characteristics of the Dubbs process and its accomplishments (see p. 10, *supra*). For ascertaining the invention which Dubbs intended to claim and the scope of his patent claim, the Court of Appeals should have given consideration to these demonstrations. *Tilghman* v. *Proctor*, 102 U. S. 707.

Analogous to these demonstrations were the practices under the Dubbs patent by leading refiners over a period of years prior to the advent of the accused process.

The evidence conclusively shows that in such practices there was exhibited the invention covered by the claims

of the Dubbs patent giving the word "vaporization" occurring therein the meaning ascribed to it by petitioner. It is unthinkable that leading refiners would have paid the royalties they did pay if, as the Court of Appeals found, in effect, their operations were clearly not within the purview of the patent.

Furthermore, a description of the phenomena, exhibited in the practice of the Dubbs process, was given by present counsel for respondent on behalf of the Winkler-Koch confederacy (including this respondent) in the *Root* case as hereinbefore set forth (footnote p. 12, *supra*); and the testimony of respondent's expert Smith in the instant case as set forth in the petition is to like effect (footnote p. 12, *supra*).

(b)

As we have seen, the opinion and judgment of the Circuit Court of Appeals for the Third Circuit sustained and vitalized the patent; the opinion and judgment of the Circuit Court of Appeals for the Seventh Circuit in effect destroyed it. These opinions are in direct conflict on the meaning of the critical word "vaporization". We have shown, and respectfully submit, that the word, as used in the Dubbs patent, is not properly susceptible of the meaning given to it by the Court of Appeals in the instant case. Even if it might be said that the word, as used in the patent, is susceptible of two interpretations because *per se* it is differently used, then we respectfully submit that, since the invention was one of great value, the word should in the Dubbs patent be given that meaning which is calculated to secure to the patentee "the fruits of his invention", rather than a meaning which in effect destroys the patent. *Smith* v. *Snow*, 294 U. S. 1, 7, 14 and cases there cited.

(c)

The Court of Appeals in the instant case stated that "at best the invention was in the nature of an improvement and the language of the claim should be construed accordingly." The construction of the claim in this case turning upon the meaning of the word "vaporization" as used in the patent, it is submitted that whether the invention was a pioneer or an improvement has no relevancy. The rule, *ut res magis valeat quam pereat,* is applicable whether the patent be for a new art or for a meritorious improvement. *Smith* v. *Snow,* 294 U. S. 1, 14; *Eibel Co.* v. *Paper Co.,* 261 U. S. 45, 63.

(d)

In finding non-infringement of the Egloff patent, the Court of Appeals said that the record shows that "defendant's structure is far out of the reach of Egloff's disclosure," and that its process differs both in additions and eliminations of steps of its process. It is believed that as to apparatus, respondent's is as accurate a replica of the apparatus of the Egloff patent as is ever found where a defendant knowingly appropriates the valuable invention of a patent, the claims of which he hopes to evade.

However, it has been settled by this Court that difference in apparatus has no bearing upon the question of infringement of a process patent. *Smith* v. *Snow,* 294 U. S. 1; *Cochrane* v. *Deener,* 94 U. S. 780; *Tilghman* v. *Proctor,* 102 U. S. 707.

In Egloff, as in the case last cited, the precise temperatures used were not of controlling importance. Egloff accomplished an important result by incorporating with the Dubbs process a once-through system for giving the Dubbs

fresh feed a preliminary screening action and thereby producing a better fresh feed for his cracking tubes with but a slight additional expense in installation and operation. Manifestly additions to the Egloff process would not exculpate respondent from infringement, nor would the elimination of a step, unless it was one which is included in the claim; and not even then, if some equivalent for it was used. On these points the Court of Appeals is silent.

## POINT 3

### THE PATENT OFFICE PROSECUTION OF THE APPLICATION FOR THE DUBBS PATENT IS IRRELEVANT TO THE INFRINGEMENT ISSUE.

The Court of Appeals, noting that claim 7 of the patent was allowed after there had been added the phrase reading, "where the oil is heated to the cracking temperature but substantial vaporization prevented," said that without this addition the prior rejection of the claims would have stood, and held, inferentially at least, that the addition excluded respondent's process from its purview.

That the phrase was added by amendment does not aid respondent, since its process employs the feature, as Judge Holly in effect found, which is described by the word "vaporization", in the sense ascribed to it by petitioner. It must be given that meaning if the canons of claim interpretation enunciated by this Court are observed. *Smith* v. *Snow*, 294 U. S. 1 and cases there cited.

The phrase, "substantial vaporization prevented", was not added to distinguish the Dubbs rejected claim from the citations in the Patent Office letter of rejection and the subject matter thereof has nothing to do with the crux of the Dubbs invention.

## CONCLUSION

For the foregoing reasons it is submitted that the petition should be allowed and the judgment of the Circuit Court of Appeals for the Seventh Circuit reviewed and reversed.

Respectfully submitted,

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